

**REMARKS**

Claims 1-20 are pending. Claims 1-3, 13-15, 18-20 are canceled without prejudice. Claims 4-12, 16, and 17 are rejected. Claim 4 has been amended to recite the method of performing a diagnostic procedure, which the Examiner indicated as allowable (page 3, note and page 7 note). Claim 16 has been amended as suggested by the Examiner to overcome the enablement rejection, as well as to correct a clerical error in which the term "compound" was inadvertently omitted. Applicants submit that no new matter has been added.

As requested, applicants provide a complete listing of their co-pending applications and issued patents directed to optical imaging.

<u>Serial No.</u>	<u>Filing Date</u>	<u>Serial No.</u>	<u>Filing Date</u>
6,397,257	01/18/00	6,656,451	10/13/00
6,180,087	01/18/00	10/680,338	10/07/03
6,180,086	01/18/00	09/864,011	05/23/01
6,183,726	01/18/00	6,641,798	05/23/01
09/688,949	10/13/00	10/654,033	09/03/03
6,669,926	10/13/00	09/757,332	01/09/01
10/744,334	12/23/03	09/757,333	01/09/01
6,663,847	10/13/00	6,183,726	01/18/00
10/436,759	05/13/03	09/981,271	10/17/01
6,673,33	10/13/00	09/978,725	10/17/01
10/751,232	01/02/04	09/981,206	10/17/01
98/688,946	10/16/00	10/071,779	02/07/02
10/653,728	09/02/03		

Applicants are unclear as to the Examiner's characterization of "overlapping subject matter", and respectfully disagree.

Applicants appreciate the Examiner's note (page 8, paragraph 12) that the supplemental Information Disclosure Statement was inadvertently placed in the wrong application; it has been properly filed in the correct application.

#### **CLAIM REJECTIONS - STATUTORY DOUBLE PATENTING**

Claims 4-12, 16, and 17 are rejected under 35 U.S.C. §101, Double Patenting. Applicants respectfully disagree.

Applicants respectfully submit that claims 4-12, 16, and 17 of the present invention do not claim the same invention as claims 4-12, 16, and 17 of co-pending Application Serial No. 09/757,333 because the aliphatic spacers between the central cyclic ring and the indole ring can never be the same in formula 1 in the present invention, and formula 3 in 757,333. The length of the spacers (defined by the numerical values of  $a_3$  and  $b_3$ ) in formula 1 can only be either 0 atoms or an even number of carbon atoms. For example, where  $a_3 = 0$ , there is no carbon atom spacer between the adjoining indole ring and the central cyclic ring. Similarly, where  $a_3$  or  $b_3 = 1$ , there will be a two carbon spacer between the ring structures. Likewise, where  $a_3$  or  $b_3 = 2$ , there will be a four carbon spacer between the ring structures, and so forth, with the spacer length increasing by two carbon atoms as the values of  $a_3$  and  $b_3$  increase. Thus, the spacers in formula 1 can only have an even number of carbon atoms.

With respect to formula 3 in 757,333, the length of one spacer is limited to one carbon atom. Moreover, the length of the second spacer between the ring

structures can never be either 0 or an even number of carbon atoms. At minimum, it must be at least one atom in length. For example, where  $a_5 = 0$ , the length of the spacer between the indole ring (substituted with X5) and the central cyclic ring structure is one atom. Similarly, where  $a_5 = 1$ , the length of the spacer is three carbon atoms. Likewise, where  $a_5 = 2$ , the length of the spacer is five carbon atoms, and so forth. As  $a_5$  increases in numerical value, the carbon atom spacer must always be an odd number.

Due to differences in the length of the spacers encompassed within the compounds of formula 1 in the present invention, and formula 3 in 757,333, these structures can never be identical. For the foregoing reasons, Applicants respectfully submit that the statutory double patenting rejection must be withdrawn.

#### **CLAIM REJECTIONS - OBVIOUS TYPE DOUBLE PATENTING**

Claims 4-12, 16, and 17 are rejected under obviousness-type double patenting over claims 8, 9, 15-17, and 19 of co-pending Application Serial No. 09/981,206. Upon allowance of the 981,206 application, applicants will file a Terminal Disclaimer which, as indicated by the Examiner, will overcome the obviousness-type double patenting rejection.

#### **CLAIM REJECTIONS UNDER 35 U.S.C. §112**

Claim 16 is rejected under 35 U.S.C. §112 as not enabled for preventing *in vivo* or *in vitro* fluorescence quenching. Applicants have amended this claim to replace the term "prevent" with "inhibit", as suggested by the Examiner. Applicants

thereby respectfully request that this rejection be withdrawn.

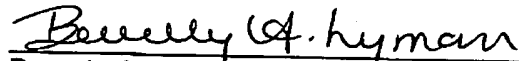
### **CONCLUSION**

For the foregoing reasons, applicants submit that the claims are in complete condition for allowance, and a Notice of Allowance is respectfully requested. Applicants do not believe any fee is due with this submission, however, the Examiner is authorized to charge any fees due to Deposit Account No. 23-3000.

The Examiner is invited to contact applicants' undersigned representative with any questions.

Respectfully submitted,

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